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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/787,919

06/01/2001

Karlheinz Mayer

MAYE3003/JEK

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05/12/2004

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EXAMINER

NGUYEN, ANTHONY H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/787,919

Applicant(s)

MAYER ET AL.

Examiner

Anthony H Nguyen

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2854

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3, 20 and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hutton et al. (US 4,033,059).

With respect to claims 1 and 2, Hutton et al. teaches a data medium 11 having an image 12 which includes a first ink area 14a and a second ink area 14 b (Hutton et al., Figs.1,3,10 and 15). The ink layer thickness of the ink areas are different and separated by a sharp border line between the ink layers' areas. With respect to claim 20, Hutton et al. teaches the ink areas which are linear (Figs. 12-15, ink area lines 53 and 55). With respect to claims 20 and 23, Fig.3 of Hutton et al. shows the border line 22 between the ink areas 14a and 14, and Fig. 15 shows a border line 53 and 55 on which the ink areas do not intermingle with one another.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hutton et al. (US 4,033,059).

Hutton et al. teaches all that is claimed, except for the minimum in the region of the border line on which the ink layer thickness of both ink areas passes through is almost zero. However, it would have been obvious to one of ordinary skill in the art to select a desired ink having viscosity in the Hutton et al. so that the inks can pass through the area in the region between the ink layer areas 53 and 55 of the Hutton et al. that forms an ink layer which is almost zero for easier of printing different ink layers which are directly adjacent to each other.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-3,20 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Hutton et al. does not teach a data medium having first and second ink areas which do not intermingle with one another, and that the ink areas which are separated by a discrete and acute borderline that is not visible to the naked eye as recited in claim 1.

However, it appears to be a gap between the ink areas 53 and 55 that is not visible to the naked eye as shown in the Figure 15 of Hutton et al.

Applicant argues that Figure 15 of Hutton et al. does not support in the written description as a whole and that the Figures 12-14 of Hutton et al. have been ignored.

As explained above, it is clearly that Fig.15 of Hutton et al. read on the broad structure as recited in the claims. Figures 12-14 of Hutton et al. which show other embodiments of Hutton et al. appears to read on the structure as argued by applicant that there is a clearance between the adjacent in areas as required by claim 1.

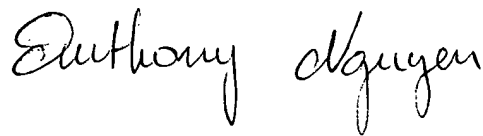
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*Conclusion*

The patents to Gulick and Wicker are cited to show other structures having obvious similarities to the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink that reads "Anthony Nguyen". The signature is written in a cursive, flowing style.

Anthony Nguyen  
5/6/04  
Patent Examiner  
Technology Center 2800